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Patent INFO : The Canadian  
Patent Office Newsletter



# Patent INFO

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The Canadian  
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Newsletter

Volume 1, No. 1, July 1988



Bill C-22, dubbed the Drug Bill by the media, was designed in the larger context to facilitate Canadian access to international patent protection and to help Canadian business better exploit the commercially valuable information contained in patents. It was given Royal Assent on November 19, 1987. While a few amendments came into force on that day, most of them will be phased in by proclamation over the next year.

You will find below a list of the amendments that came into force with Royal Assent and upcoming changes to the Patent Act.

## AMENDMENTS NOW IN FORCE

### Abrogation of marking patented articles:

The previous Patent Act obliged patentees to indicate the year of issuing of their patent on patented articles. That requirement was removed as being out-of-date and having no real benefit.

### Pharmaceutical and Food Products:

The section of the Act which deals with drugs (section 41) has been amended as follows:

### New section 41(1):

The Canadian Patent Office will now allow claims to a food or medicine per se except for naturally occurring substances made by microbiological process. This limitation with respect to microbiology will expire four years after Royal Assent. Pending applications may be amended to change claims from chemical-process-dependent to per se form.

### New sections 41.1 to 41.25:

These sections were proclaimed on December 7, 1987. They are related to the pharmaceutical industry and drug pricing.

### MAIN AMENDMENTS TO COME INTO EFFECT

- ratification of the Patent Co-operation Treaty
- early publication
- first to file system
- absolute novelty and grace period
- deferred examination
- term of protection
- maintenance fees
- re-examination of patents
- Patented Medicine Prices Review Board.

The above amendments will be addressed in more detail in our future issues.

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CCGC No. 191 2006 B 88-07

Le Bureau des brevets acceptera désormais les revendications pour un alliment ou un médicament, à l'exception des substances que l'on trouve dans la nature, produites selon un processus microbiologique. Cette restriction concerne les substances microbioniques exprimées dans quatre ans, à compter du 19 novembre 1987. Les demandes en instance peuvent être modifiées pour changer les revendications

Les sujets ci-haut mentionnés seront traités plus en détail dans nos prochains bulletins.

- L'anigie concerneait les médicaments et les produits alimentaires, soit l'article 41, a été modifié comme suit:

#### **Nouveau paragraphe 41(1) :**

#### • Conseil d'examen du prix des médicaments.

#### • réexamen des brevets

#### • taxe périodique

#### • durée de protection

#### • examen différencier

#### **• nouveauté absolue et période de grâce**

#### • système du premier déposant

#### • Publication anticipate

#### ratification du Traité de coopération en matière de

## PRINCIPALES MODIFICATIONS À VENIR

Ces paragraphe sont entrés en vigueur le 7 décembre 1987. Ils se rapportent à l'industrie pharmaceutique et à la fixation du prix des médicaments.

Nouveaux paragraphes 41.1 à 41.25 :

ondées sur un processus unique en des revendications fondées sur un objet en sol.

Vous trouverez ci-dessous une liste des modifications déjà en vigueur, ainsi qu'une énumération de celles qui seront proclamées ultérieurement.

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## **Abrogation du mariage :**

Volume 1, No 1, juillet 1988

Bulletin du Bureau canadien des brevets

**INFO Brevet**

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The Canadian  
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Vol. 1, No. 2, September 1988

The amended Patent Act, given Royal Assent on November 19, 1987, has some provisions which will become increasingly important as the new Act becomes proclaimed over the coming months. The change in the way the new law regards novelty is one of these.

## ABSOLUTE NOVELTY

Novelty has always been a condition of patentability in Canada. The novelty under the 'old' Act, however, was a relative one; an invention could be described in a publication or sold by anyone during the two years before filing and still be considered novel. The new Act will now require 'absolute novelty', i. e., any public disclosure will bar grant of a patent. There is, however, in Canada, an exception, provided by the 'grace period'.

Under the old Act applicants could "swear back" and thereby overcome an earlier publication. They could state that they had made their invention before it was made public by someone else. Under the new Act they cannot overcome an earlier publication. Any publication, sale, use, or prior application on the same invention will bar a patent. Only an earlier priority date, i. e., an earlier foreign filing date by the applicant can overcome the bar, unless the grace period provision applies.

## GRACE PERIOD

The new Act provides a one-year grace period prior to filing an application for a patent, during which the inventor or those who learnt about it from him or her may disclose the invention without creating a bar against the grant of a patent. Canada differs from many countries in this respect. In some countries there is no grace period, or it is shorter. Other countries restrict disclosure of inventions during the grace period; for example, that disclosures be made at trade shows sponsored by their Governments. Canadian inventors who disclose during the grace period may not be able to obtain patents in these countries.

The grace period, however, can be rendered ineffective by a competitor who improves on a disclosed invention for which an application has not been filed, and 'describes' it in an application. Irrespective of how the

competitor learnt about it, the grant of a patent on the original invention is barred by the filing of the improvement application. So, going public, even in Canada, is dangerous before the filing of an application!

During the transitional period, intending applicants must make sure that if their inventions have already been disclosed, they apply while the old Act is still in effect; unless, of course, the disclosure was made during the grace period by them or someone who learned of the invention from them.

## TERM OF PROTECTION

The old Act provides that patents are granted for 17 years from their date of issue. Under the new Act, they will come into force on their date of issue and expire 20 years after filing (earlier if maintenance fees are not paid). Infringers will be liable to pay for damages suffered after grant.

Protection, however, which is dependent on grant of patents, will become retroactive to the date of publication, 18 months after filing. From publication to grant, infringers will be liable "to pay reasonable compensation" for damages once a patent is granted. The two kinds of compensation, as determined by the courts, may be different.

## MARKING

The requirement in the old Act to mark patented articles as 'patented' has been repealed; this change is one of the few already in effect. However, falsely marking an article as 'patented' if it is not patented in Canada, is still an offence. It is similarly wrong to mark an article patented by someone else as 'patented' in order to pretend that the article is made by the patentee.

Whether to mark an article with 'patent pending' or 'patented', provided that the statements are true, will now be solely questions of marketing strategy.

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C&CC No 191 2009 B 88-09

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Pourvu que ces déclarations  
soient dans le sens de la révolution,  
on peut porter les indications  
brèves de cette révolution.

La prescription de l'ancienne loi exigeant que la prescrivee soit la personne qui a breveté, afin de laisser supposer que l'article "brevete" dans un article breveté par une autre personne est une infraction. Par ailleurs, il est défendu d'indiquer "brevete" si le test pas au Canada constitue toujours "breveté", l'indication fausse qu'un article est abrogé; cette modification est déjà en vigueur. Cependant, l'indication est tant que "brevete" a été abrogée;

MARGAUGE

dommages-intérêts. Cependant, la protection, qui dépend de l'octroi des brevets, deviendra retrospective à la date de la publication soit, 18 mois après la date de dépôt. De la publication à la date de dépôt, les contrevenus seront passibles "de verser une indemnité pour les préjudices causés une fois que la demande de brevet est devenue accessible. Les deux types d'indemnisation, qui servent établis par les tribunaux, pourraient être différents.

17 ans à partir de la date d'octroi du brevet. En vertu de la nouvelle loi, les brevets entrent en vigueur à la date de l'octroi et expirent 20 ans après la date du dépôt (ou moins si les taxes de maintien ne sont pas payées). Les contrevenants seront responsables des préjudices subis après l'octroi et devant payer les

DURÉE DE LA PROTECTION

Au cours de la période de transition, les demandes doivent, si leurs invénients ont déjà été divulguées, s'assurer qu'ils déposent leurs demandes pendant que l'ancienne loi est toujours en vigueur. C'est, bien entendu, pas le cas si le demandeur ou une personne qui ou elle a misé au courant de l'invention n'est, bien entendu, pas le cas si le demandeur. Ce procédé à la divulgation au cours du délai de grâce

déposée et la "décrit" dans une demande. Le dépôt d'une demande d'amélioration empêche l'octroi d'un brevet sur l'invention originale, peu importe la façon dont le concurrent en a pris connaissance. Ainsi donc même au Canada, il est dangereux de rendre publicue une invention avant le dépôt d'une demande.

Vol. 1, No 2, septembrie 1988

Bulletin du Bureau canadien des brevets

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The Canadian  
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Newsletter

Vol. 1, No. 3, October 1988

## CONFLICT

Conflict, a procedure that delays patent prosecution, is being phased out under the new Patent Act. Conflict under the old Act exists between two applications pending at the same time when at least one claim in one application defines what another application claims or discloses. In some fast-developing areas dozens of applications could be in conflict because their inventions were all made about the same time. The determination of "the prior inventor" is an involved procedure that can take many months. Conflict, under the new Act, could still occur between two or more applications if at least one of them was filed under the old Act.

Under the absolute novelty provisions of the newly-amended Patent Act, the first inventor to file is entitled to a patent provided all the criteria for patentability are met. Two applications filed on the same date and describing the same invention, however, will both issue as patents. There will be no conflict between them. A later filing can overcome an earlier one only if the later filing has an earlier Convention priority date.

## EXAMINATION

Under the old Act all applications had to be examined in the Canadian Patent Office. Under the new Act, examination of applications will be done only when requested by the applicant or by a third party. However, the Commissioner will be able to require an applicant to request examination. If no one requests examination during a period to be set in the Rules and proposed to be seven years, or if the applicant fails to request examination when ordered to do so, the application will be abandoned. An abandoned application may be reinstated by petition and on payment of another fee.

Applications already filed under the old Act will continue to be examined. Implementation of the new Act will reduce the examination load of the Patent Office, allowing the examiners to reduce the backlog of the many thousands of applications pending under the old Act.

It is difficult to assess how many requests for examination will be received under the new Act;

however, it is generally believed that a large number of applications will not require examination. These will be published, but they will not be issued as patents.

## RE-EXAMINATION

Anyone may ask that one or more claims of a patent be re-examined. The request must be supported by prior art and a fee paid. The requestor must also set out the pertinency of the prior art and the method of applying it against the claims. The Commissioner of Patents is then required to establish a re-examination Board. Should the Board find that new questions of patentability have been raised, it notifies the patentee who, in turn, may amend or present arguments in support of the claims. However, claims cannot be broadened. The Board must re-examine the claims in dispute and issue a ruling. After re-examination, the Board will issue a certificate cancelling, confirming, or amending claims. Any decision in such a certificate is appealable to the Federal Court within three months.

## THE ROADSHOW

The Commissioner of Patents, J. H. A. Gariépy, accompanied by a specialist and a co-ordinator from the Patent Office, gave 16 presentations on the new Patent Act and Rules in 13 Canadian cities, from coast to coast and from the U. S. border to the Yukon, last June and July. Total attendance was 550, including 28 journalists. Members of the public were invited to submit comments on the proposed Rules required to administer the new Act. The comments made will be evaluated and taken into consideration in the final drafting of the Rules.

Finally, the Rules relating to the general revision of the Act and those relating to the implementation of the Patent Co-operation Treaty will be published in Part I of the Canada Gazette, at which time there will be a final 30-day period for comments and suggestions for changes.

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The Canadian  
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Vol. 1, No. 3, October 1988

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Les règles concernant la révision générale de la Loi et la mise en œuvre du Traité de coopération en matière de brevets seraient publiées dans la Partie I de la Gazette du Canada. Cette publication servirait d'un délai de 30 jours réservé aux observations et proposerions de modification.

Le Commissaire des brevets, J.H.A. Garepy, a commencé une campagne d'un spécialiste et d'un coordinateur du Bureau des brevets, à présenter 16 séances d'information sur la nouvelle Loi des brevets et sur les règles. Ils ont procuré le pays d'un océan à l'autre et du Yukon à la frontière américaine en personne dans 13 villes. Chaque séance a été suivie par des personnes qui participent aux séances, dont 28 journalistes. Le public a été invité à soumettre ses observations sur les règles proposées, régles qui serviront à l'application de la nouvelle Loi. On tiendra des séances publiques lors de la rédaction finale des règles.

SÉANCES D'INFORMATION

REEXAMEN

de la gagnon générale du grand nombre d'entre elles nécessiteront pas d'examen. Ces demandes seront publiées, mais ne donneront pas lieu à la délivrance de brevets.

Vol. 1, No 3, octobre 1988

Bulletin du Bureau canadien des brevets

**INFE** Brevet

Une pétition et le paiement d'une autre taxe. Les demandes qui ont été déposées en vertu de l'ancienne loi se sont toutes examinées. La mise en oeuvre de la nouvelle loi réduira la charge de travail du Bureau des brevets au chapitre des examens. Ceci permettra donc aux examinateurs de réduire l'arriéré qui s'élève à plusieurs milliers de demandes. Il est difficile d'évaluer le nombre de demandes d'examen que recevra le Bureau. Cependant, il semble

EXAMEN

Conformément aux dispositions relatives à la nouveauté absolue de la nouvelle version de la Loi sur les brevets, le premier inventeur à déposer une demande est celui qui a droit à un brevet -- à condition que l'invention soit brevetable. Toutefois, deux demandes déposées à la même date et qui décrivent la même invention donneront toutes deux lieu à la délivrance de brevets et ce, sans qu'il y ait conflit entre elles deux demandes. Un dépôt ultérieur peut supplanter un dépôt antérieur uniquement lorsqu'il porte une date de priorité conventionnelle antérieure.

En vertu de la nouvelle loi, les problèmes reliés au conflit seront graduellement éliminés. Selon Lan- cienne loi, il y avait conflit entre deux demandes en instance en même temps lorsqu'au moins une revendica- tion d'une demande définissait ce qu'une autre demande revendiquait ou divulguait. Lorsqu'il y a con- flit, l'examen des demandes de brevet est considérablement relâché. Parfois, il faut plusieurs mois pour déterminer lequel parmi les demandeurs est l'inventeur着实. Notamment, dans les domaines où l'évolution est rapide, des dizaines de demandes peuvent être en conflit parce que les inventions ont toutes été réalisées à peu près au même moment. Desormais, les seuls cas de conflit qui pourront surgi- brevet déposéee sous le régime de l'ancienne loi.

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The Canadian  
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Vol. 2, No. 1, May 1989

## PUBLICATION

Patents in Canada have always been made public when granted. Under the 'old' Patent Act the Commissioner of Patents published in the Patent Office Record the title, number, classification and ownership of granted patents. Applications were always kept secret until they were issued as patents.

The amended Act, however, provides for a patent application to be open to inspection by the public on the earlier of: 18 months after the application is first filed in Canada, or, if there is foreign priority, 18 months after the priority date. Applications withdrawn within 18 months of filing or convention date are not made public.

The Commissioner intends to publish weekly a list of all patents issued; he will also publish lists of applications laid open to the public.

## PATENT CO-OPERATION TREATY

The new Patent Act makes special reference to the Patent Co-operation Treaty (PCT) of 1970. Canada plans to join some 40 countries in ratifying PCT. An applicant need file only one application, in his or her home country, instead of filing independently in every country where protection is required. Canada intends to accede to Chapters I and II of the Treaty. Chapter I provides for a search report, showing the prior art relevant to the invention being described. Under Chapter II, a preliminary examination is also done.

The PCT will give Canadian applicants the benefits of lower or delayed costs of translation and prosecution. For example, instead of filing in the language of each country and paying within a year of first filing all translation, filing and agents' fees, PCT applicants will have about 18 months under Chapter I. If Canada were to join Chapter II as well, payment of costs could be delayed 30 months. The additional time could be used on other matters such as raising capital and marketing studies. In addition, Chapter II provides an applicant with an examination report, that is, an official opinion on the patentable merits of the application. An applicant, therefore, has a basis for deciding whether or not to take on the expense of multiple patents before these fees are due.

In an international application an applicant files in one language in his or her country and designates countries in which he or she would like a patent. This application is verified for certain formalities and sent to the World Intellectual Property Organization (WIPO) in Geneva for subsequent publication. A copy is also sent to one of the International Searching Authorities, acting for his or her country, for the establishment of a search report. Canada may consider becoming a search and examining authority. The Searching Authority reports to the applicant, who may amend his or her application at that point. WIPO publishes the application 18 months after the priority date and sends a copy of both the application and the report to the patent offices of the countries designated by the applicant as filing countries.

Publication will be in one of English, French, German, Japanese or Russian, according to the language of application; those applications published in a language other than English will have attached to them an English-language abstract. Applicants with applications written in English or French may have to provide translations into the languages of the designated countries if this is required.

An application under PCT made in Canada will be regulated by a group of rules made under Section 12 of the Patent Act which will in no way conflict with the Canadian regulations for a normal national filing.

Applications received in the Canadian Patent Office acting in its capacity as a receiving office must be in English or in French, and they will be available to the public 18 months after their filing dates. Applications in which Canada is 'designated' by a foreign applicant will be published in Geneva by WIPO. Requirements concerning completion, abandonment and reinstatement will be dealt with when the application enters the national phase.

The public will be informed when the provisions of the Patent Co-operation Treaty will go into effect.

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PUBLICATION

Vol. 2, No 1, mai 1989

Bulletin du Bureau canadien des brevets

**INFE** Brevet

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Le public sera avisé lorsqu'e les dispositions du Traité de coopération en matière de brevets entraîneront en vigueur.

Les demandes régulées au Bureau des brevets du Canada, en sa qualité de bureau de réception, doivent être redigées en singulais ou en français, et elles sont mises à la disposition du public 18 mois après leur date de dépôt. Les demandes dans lesquelles le Canada est un pays "designé" par un demandeur étranger sont publiées à Genève par l'OMPI. Il est question des exigences applicables à l'exécution, à l'abandon et au renouvellement lorsqu'e la demande en est à l'étape

Une demande déposée au Canada en vertu du Traité est rejeté par un ensemble de régles établies aux termes de l'article 12 de la Loi sur les brevets, qui n'entrent pas en conflit avec la réglementation canadienne dans le cas d'un dépôt ordinaire à l'échelle internationale.

Selon le Traité, la publication se fait en anglais, en français, en allemand, en japonais ou en russe, selon la langue de la demande. Les demandes publiées dans une langue autre que l'anglais sont accompagnées d'un abrégé en anglais. Les demandes qui déposent des demandes érites en anglais ou en français doivent présenter, sur demande, des traductions dans les langues des pays designés.

Si une demande internationale est déposée dans le pays du Traté, elle l'est dans une seule langue, dans lesquels il souhaite obtenir le brevet. Cette demande est vérifiée relativement à certaines formalités et elle est envoyée à l'Organisation mondiale de la propriété intellectuelle (OMPI). Une copie est également envoyée à l'une des administrations chargées de la recherche interationale qui représente son pays afin qu'un rapport de recherche soit préparé. Le Canada envisage de devenir une administration de recherche au demandeur, qui peut alors modifier sa demande, au bureau des brevets des pays designés par le L'OMPI publie la demande 18 mois après la date de priorité et envoie copie de la demande et du rapport d'examen. L'administration de recherche fait rapport au demandeur, qui peut alors modifier sa demande.

non il assumerà les dépenses entraînées par les bre-  
vets multiples avant de devoir payer ces frais.

## TRAITE DE COOPÉRATION EN MATIÈRE DE BREVETS

La nouvelle loi sur les brevets fait référence tout spécialement au Traité de coopération en matière de brevets de 1970. Le Canada a l'intention de ratifier ce Traité, se joignant ainsi aux quelque 40 pays qui l'ont déjà approuvé. En vertu du Traité, un demandeur ne doit déposer qu'une seule demande de brevet de l'origine, plutôt qu'un dépôt des demandes distinctes dans tous les pays où une protection est nécessaire. Le Canada a l'intention d'adhérer aux chapitres I et II du Traité. Le chapitre I prévoit la présentation d'un rapport de recherche, qui fait partie de l'état antérieur de la technique en ce qui concerne l'invention décrite. Le chapitre II prévoit un examen préliminaire.

Au Canada, les brevets ont depuis toujours été renouvelés publics après leur octroi. En vertu de l'ancienne loi sur les brevets, le Commissaire des brevets publiait dans la Gazette des brevets le titre, le numéro, la classification et le nom du titulaire des brevets octroyés. Les demandes étaient toujours gardées secrètes jusqu'à la délivrance des brevets. La classification des brevets était toujours numérotée, la classification et le nom du titulaire des brevets étaient toujours gardées secrètes jusqu'à la délivrance des brevets. Les demandes étaient toujours gardées secrètes jusqu'à la délivrance des brevets. Aux termes de la Loi modifiée, une demande de brevet peut être consultée par le public 18 mois après son premier dépôt au Canada ou, si l'y a priorité étrangère, 18 mois après la date de priorité, selon ce qui survient en premier lieu. Les demandes rejetées dans les 18 mois suivant le dépôt ou la date de priorité sont égalemment mises à la disposition du public. Le Commissaire a l'intention de publier chaque semaine la liste complète des brevets délivrés; il publie également une liste des demandes soumises à la demande de brevet.

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The Canadian  
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Newsletter

Vol. 2, No. 2, December 1989

The new Patent Act, given Royal Assent November 19, 1987, was proclaimed October 1, 1989. This issue of PatentINFOBrevet reviews some of the most important new provisions in the amended Act.

## ABSOLUTE NOVELTY

The new Act changes the standard of novelty required for obtaining a patent. Canada will not grant a patent for an invention that has been disclosed before the Canadian filing date or the foreign priority filing date.

There is, however, one exception to this general rule. Public disclosure of an invention by the applicant, or a person who knew of the invention directly or indirectly from the applicant, is allowed if the disclosure is made less than one year ("grace period") before the Canadian filing date.

## FEES

For small entities there is a filing fee of \$150, an examination fee of \$200 and a final fee of \$150. Large entities pay twice as much. Annual maintenance fees of from \$50 to \$200 will have to be paid by small entities from the second to the 19th year after filing. Large ones will pay double.

## PUBLICATION

The amended Act provides for an application to be open to inspection by the public. This can happen either 18 months after the application is first filed in Canada, or, if there is foreign priority, 18 months after the priority date, whichever is earlier. Applications withdrawn within 18 months of the filing or the priority date are not made public.

## TERM OF PROTECTION

Under the new Act, patents will come into force on their date of issue and expire 20 years after filing. Infringers will be liable to pay for damages suffered after grant, and for reasonable compensation between publication and grant.

## THE FIRST-TO-FILE SYSTEM

Under the first-to-file system, the first inventor to file is entitled to a patent provided all the criteria for

patentability are met. A later filing can overcome an earlier one only if the later filing has an earlier priority date. This makes it extremely important to file an application in the Patent Office as soon as possible.

## CONFLICT

Conflict between two or more applications pending at the same time when at least one claim in one application defines what another application claims or discloses will now exist between applications only if at least one of the applications was filed under the old Act.

## DEFERRED EXAMINATION

Examination of applications will be done only when requested by an applicant or by a third party, including the Commissioner of Patents. If no request for examination is received during the first seven years, the application will be abandoned. All applications already filed under the old Act will all continue to be examined.

## RE-EXAMINATION

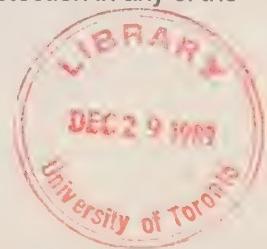
Anyone may ask that one or more claims of a patent be re-examined. The request can only be based on prior art. The requester must set out the pertinency of the prior art and its application against the claims. The Commissioner of Patents will then establish a Re-examination Board which will issue a certificate cancelling, confirming, or amending claims as appropriate. Any decision in such a certificate is appealable to the Federal Court within three months.

## PATENT CO-OPERATION TREATY (PCT)

Canada will join some 40 countries in ratifying the Patent Cooperation Treaty. The Treaty comes into force for Canada on January 2, 1990. Under that Treaty, an applicant will be able to file one application in Canada and ask for patent protection in any of the 43 signatory countries.

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Le Canada se joint à quelque 40 pays afin de ratifier le Traité de coopération en matière de brevets. Le Traité entre en vigueur au Canada le 2 janvier 1990. En vertu de cette loi, on pourra déposer une demande de brevet au Canada et demander la protection conférée par le brevet dans n'importe quel des 43 pays signataires.

BREVETS (ICB)

#### LE TRAITE DE COOPÉRATION EN MATIÈRE DE

Toute personne peut exiger qu'une ou plusieurs revendications d'un brevet soitient réexaminées. Cette demande ne peut être fondée que sur l'antériorité. Le demandeur doit établir la pertinence de l'autorité revendicative ne peut être fondée que sur l'antériorité. Le com-  
muniste que son impact sur les revendications. Le conseil missaire des brevets mettra alors sur pied un conseil de reexamen qui délivrera un certificat annulant, confirmant ou modifiant les revendications, selon le cas. Toute décision contenue dans un tel certificat peut faire l'objet d'un appel devant la Cour fédérale dans les trois mois suivants.

REEXAMEN

L'examen des demandes ne sera effectué que si celles-ci sont établies par celle qui présente la demande ou une tierce partie, y compris le commissaire des brevets. Si aucune requête d'examen n'est présentée au cours des sept premières années suivant le dépôt original, la demande sera abandonnée. Toutes les demandes déjà déposées en vertu de l'ancienne loi continueront d'être examinées.

EXAMEN DIFFÈRE

Un conflit entre deux demandes ou plus en instance révélera dorénavant que si au moins une demande revendique ou divulgue des demandes, déposée sous l'ancienne loi, contenues au moins une revendication qui définit ce qu'une autre demande revendique ou divulgue.

CONFLICTS

une demande de brevet, à condition que tous les critères de brevetabilité soient satisfait. Un dépôt ultérieur peut prévaloir sur un dépôt antérieur seul- ment s'il porte une date de dépôt antérieur. Il est donc extrêmement important de déposer sa demande le plus tôt possible au Bureau des brevets.

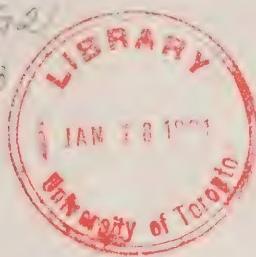
Vol. 2, N° 2, décembre 1989

Bulletin du Bureau canadien des brevets

# Patent INFO

The Canadian  
Patent Office  
Newsletter

Vol. 3, No. 1, November 1990



## COMPULSORY LICENCES

The Patent Act provides for compulsory licences to manufacture, use, or import patented products or processes. Compulsory licences may be granted to allow the manufacture of foods, the manufacture or importation of pharmaceuticals, or to overcome abuses of patent rights. The terms of compulsory licences, which may include royalties, are settled by the Commissioner of Patents. The Commissioner's decisions are appealable to the Federal Court.

### MEDICINES AND FOOD

The so-called 'drug' section, now s. 39 of the Patent Act, gives the Commissioner of Patents authority to grant a compulsory licence to manufacture a food or to manufacture or import a medicine into Canada. In settling the terms of the licence and fixing the royalty payable, the Commissioner must weigh the desirability of making the food or medicine available at the lowest price with the need to ensure patentees receive due reward for their inventions.

Patent Act amendments which came into force on December 7, 1987 created periods of market exclusivity for patentees during which only the patentee of a medicine can sell it. Essentially, these periods of exclusivity are seven years for manufacturing in Canada and ten years for importing into Canada. In each case, the period of market exclusivity runs from the date of the first Notice of Compliance granted by Health and Welfare Canada.

In the case of foods, compulsory licences may be obtained only to manufacture the food in Canada. There are no periods of exclusivity as in the case of medicines.

There will be a review of the legislation on drugs in 1996.

### ABUSE OF PATENT RIGHTS

Sections 64 to 70 provide another route to obtain compulsory licences to manufacture. Grant of a compulsory licence under these sections is one of the remedies available to the Commissioner if a patentee has abused his or her patent rights.

Abuse occurs if a patented invention is not being worked on a commercial scale in Canada without good reason, or if working a patent in Canada is being hindered by importation by the patentee or by someone against whom the patentee has not taken infringement action.

There is also abuse if demand in Canada is not being filled on reasonable terms: if trade or establishment of new trade or industry is prejudiced by the patentee refusing to grant a licence on reasonable terms, and such a licence is in the public interest, or if such a licence has unreasonable conditions attached. Abuse also occurs if the existence of a process patent is used to prejudice unfairly production of its non-patented product, or if a patent on such a product unfairly prejudices its manufacture, use or sale.

An application for relief alleging abuse can be made at any time following three years after grant. If the Commissioner thinks, however, that because of the nature of the invention, three years is not sufficient for working on a commercial scale, he can provide the patentee more time. The Commissioner must take into account that patents are granted "not only to encourage invention but to secure that new inventions shall, so far as possible, be worked on a commercial scale in Canada without undue delay."

Under the abuse sections, compulsory licences can be granted which include prohibitions against importing for a specified period of time.

The Commissioner, if he believes a compulsory licence would not end the abuse, may instead revoke a patent, or refuse an application for a compulsory licence.

In settling terms, the Commissioner tries to ensure the widest possible use of inventions in Canada while providing a reasonable return to the patentee.

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En arrêtant les conditons, le commissaire tente d'assurer la plus grande utilisation possible des invén-  
tions au Canada tout en offrant une rémunération convenable au brevete.

**S'il est convaincu qu'une licence obligatoire ne mettra pas fin à l'abus, le commissaire peut toutefois revendiquer un brevet ou refuser une demande de licence obligatoire.**

Il y a aussi abus dans le cas où la demande fait face au Canada n'a pas été remplie à des conditions raisonnables. Par exemple, si le titulaire de brevet en refuse tout de concéder une licence à des conditions raisonnables, mais qui sont évidemment réalisables dans le cas aussi où la cause soit d'intérêt public, et que la licence en cause soit mise sur pied d'un nouveau commerce ou d'une nouvelle industrie, il existe un brevet de procédé est indûment utilisé pour empêcher la production du produit visé non breveté, ou si un brevet visant le produit en question empêche l'utilisation sa fabrication, son utilisation ou sa vente, il peut être déclaré n'importe quel moment après la publication de l'invention, trois ans ne suffiront pas pour accorder plus de temps au titulaire commercial, il peut également décliner la demande pour un temps plus court, mais encore pour garantir que les nouvelles inventions servent, autant que possible, aux intérêts publics.

Il y a dans si une invention brevetée nest pas exploitée sur une échelle commerciale au Canada sans motif suffisant, ou si l'exploitation dun brevet au Canada est entravée par le fait que le titulaire n'a pas pris d'action en contreéflagon, procéde à des importations de ces articles.

recours dont le commissaire dispose dans le cas où un breveté abuse de ses droits de brevet

## HGENCES OBHGAOTIRES

Vol. 3, N° 1, novembre 1990

## *des brevets*

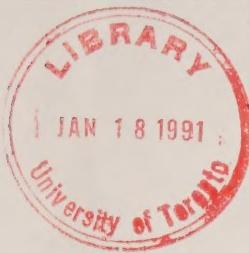
# Bulletin du Bureau canadien

INFE Brevet

# Patent INFO

The Canadian  
Patent Office  
Newsletter

Vol. 3, No. 2, December 1990



## THE CANADIAN PATENT OFFICE WILL BE COMPUTERIZED

Canada's most important technological database, the Canadian patent files, which now occupy ten kilometres of shelving in Hull, Quebec, will be computerized. The project to establish a Canadian Automated Patent System (CAPS), at a cost of some 74 million dollars, will take six years to complete. CAPS will make Canada's patents and published applications accessible to personal computers via telephone, anywhere in Canada.

### ELECTRONIC SYSTEM

By 1992, all incoming patent applications will be scanned and stored electronically. Applications will be fed into scanners to have their images stored in one file and their texts stored in another. Access to a particular application or issued patent will be available through several methods. First, one will be able to search by application or patent number, or by inventor or assignee. Second, searches will be possible by classification of the application or patent. Third, one will be able to search for key words in the title or text. Using the third method, the text file is interrogated and when keywords are found any corresponding images will be retrieved as well.

Electronic images will correspond to the paper originals, allowing the system to store and display, in addition to texts, drawings, mathematical formulae and chemical symbols, all of which are features of patent documents. Examiners will be able to view two texts or images side by side, allowing them to compare an application with an issued patent, or compare a drawing with its description.

### SYSTEM IMPLEMENTATION

CAPS will be implemented in three phases. About mid-1991, a small version, or core, of the final system will be installed. This core will consist of about 20 workstations hooked to a computer having a database about one-tenth the size of the final system. This will allow all the necessary electronic processing functions to be developed under actual user conditions. The core system will then be tested to see if it works and to ensure that it can be scaled up to meet the needs of the Patent Office's final system.

The second implementation phase will start toward the end of 1992 when the final system will be installed and workstations and terminals deployed throughout the Office. This, too, will be done in stages. A comprehensive training program will be set up to help all affected employees, particularly those who were not involved in the development, to become thoroughly familiar with the system. Following full deployment, another operational test will be done to see if it works under full load and to ensure that the system is secure.

The third and last phase is scheduled for the beginning of 1995 when access to CAPS by the patent profession and small- and medium-size businesses (SMB) will start. At this stage foreign patent data will be integrated into the system and reside in the database alongside Canadian patent data. This last phase will end in March 1996 with an audit of the entire implementation program to see if the system has met its objectives.

### DISSEMINATION

Maximizing the effective dissemination of the technological information found in patents is one of the major long-term goals of computerization and is expected to be achieved during the final phase of the project. Once the search needs of the Canadian Patent Office and the patent profession are satisfied, attention will be focused on fulfilling the needs of the SMB. This is likely to involve a variety of methods, from allowing direct access to the system, possibly with patent examiners as experts who interpret or help get the information, to publication of the information in CD-ROM format so that the SMB can search the information at their leisure.

External access will be available through five or six regional nodes across Canada. In effect, these will operate as regional patent offices through which the external user can access and be directly linked to the central Office. This will greatly equalize access across Canada--another of the goals of computerization. Direct filing of patent applications by agents from across Canada may become possible at the end of the last stage.

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L'accès extrême se fera par l'intermédiaire de cinq ou six postes régionaux répartis dans tout le Canada. En fait, ils constitueront les bureaux régionaux des brevets par lesquels l'utilisatuer extrême peut accéder et être relié directement au bureau central. Cela contribuera grandement à procurer des chances égales d'accès, dans tout le Canada -- un autre des objectifs de l'information. Le dépôt direct des demandes brevets par des agents, depuis toutes les régions du Canada, pourrait être possible à la fin de la dernière étape.

Difuser le plus efficacement possible les renseignements techniques contenus dans les brevets est l'un des principaux objectifs à long terme de l'information, et on peut satisfaire au cours de la dernière étape du projet. Une fois atteinte cette dernière étape, les brevets en matière de recherche du Bureau canadien des brevets et des professions des brevets, on occupera de combler les besoins des PME. Il est probable que cela se fera de diverses manières. On pourra par exemple permettre l'accès direct au système, peut-être avec des examinatrices des brevets agissant à titre de spécialistes qui interpréterait ou aiderait à obtenir les renseignements, ou encore publier des renseignements en format CD-ROM afin que les PME puissent chercher les renseignements à loisir.

DIFFUSION

La troisième étape est prévue pour le début de 1995, date à laquelle les professionnels des brevets et les petites entreprises (PME) commenceront à avoir accès au SCBA. À ce stade, les données sur les brevets étrangères seront intégrées au système et emmagasinées dans la base de données avec les données sur les brevets canadiens. Cette dernière étape prendra fin en mars 1996 par une vérification du programme global de mise en œuvre, destinée à déterminer si le système a atteint ses objectifs.

La deuxième étape de la mise en œuvre débutera vers la fin de 1992 : le système définitif sera alors installé et les postes de travail et les terminaux seront préparés dans tout le Bureau. Cela se déroulera également par étapes. Un programme complet de formation sera mis en place pour aider les employés touches, en particulier ceux qui n'ont pas participé à l'élabora- tion du système, à se familiariser à ceint pour cent avec ce dernier. À la suite de la répartition complète, une autre vérification fonctionnelle sera effectuée pour assurer que tous les éléments soient au point et que le système soit sûr.

LE BUREAU CANADIEN DES BREVETS SERA INFORMATISÉ

Vol. 3, n° 2, décembre 1990

Bulletin du Bureau canadien des brevets

**NFO Brevet**



